

REMARKS

INTRODUCTION

The Office Action dated November 14, 2003, and the references cited therein have been carefully considered. In response, the applicant offers the following remarks.

OFFICE ACTION REJECTIONS

Claim 1-8, 10-14 and 16-24 are rejected under 35 U.S.C. Sec. 103(a) as being unpatentable in view of U.S. Patent No. 6,146,273 ("Olsen").

Claims 9 and 15 are rejected under 35 U.S.C. Sec. 103(a) as being unpatentable over U.S. Patent No. 6,146,273 ("Olsen") in view of U.S. Patent No. 6,159,095 ("Frohm et al.").

SYNOPSIS OF PRIOR ART

U.S. Patent No. 6,146,273, inventor Olsen: A gaming machine that displays a plurality of segments apparently is disclosed. Each time the computer receives a signal, a new segment on a random basis is turned over to reveal a portion of a picture. If an eligible player is able to discern what the entire picture is, then the player is entitled to yet another prize.

U.S. Patent No. 6,159,095, inventor Frohm et al: A game wherein apparently a plurality of squares are displayed and upon the calling of a specific number, the display is changed from displaying the keno square to the highlighted version indicating a specific keno number.

ARGUMENTS FOR PATENTABILITY

All the pending independent claims have been amended to call for a plurality of first displayed items, such as playing cards (claims 1, 18 and 21), keno number spaces (claim 7) or a bingo card number spaces (claim 13), to change in a pre-determined, non random sequence at a predetermined speed to displaying a display object inside the first displayed items wherein the portions of the display object create an identifiable object. It is respectfully submitted that Olsen does not disclose or suggest changing a first item in a pre-determined, non-random sequence at a predetermined speed to displaying a display object inside the first displayed items wherein the portions of the display object create an identifiable object. Olsen discloses the following:

The display 830 is comprised of a plurality of segments 840. Each segment 840 could be in the shape of a square or rectangle as shown in FIG. 8 or in the shape of a standard jigsaw puzzle configuration. Each time the computer 800 receives signal 261 a new segment 840, **on a random basis**, is turned over to reveal a portion of a picture 850. If an eligible player is able to discern what the entire picture 850 is, then the player is entitled to yet another prize. This adds further excitement and attraction to the game.

(bold added) Col. 21, lines 17-25.

Olsen specifically calls for the new segment to be selected on a random basis which makes logical sense because Olsen is attempting to make it a challenge for the player to discern the entire picture. The pending claims call for the objects to be changed in a pre-determined, non-random sequence at a predetermined speed which also makes logical sense because the purpose of the pending claims is not to challenge the player to discern an entire picture but to briefly obscure the picture and then present the picture in a novel and eye-catching way. For example, according to the pending claims, playing cards could flip in a left to right pre-determined sequence at a speed that the player can easily track the change from displaying card backs to displaying the entire picture. The purpose is not to make the

player guess at the entire picture but to display it in a novel, eye-catching way. Accordingly, the pending claims are not anticipated by Olsen.

OBVIOUSNESS

The applicant also respectfully argues that the pending claims are not obvious in view of Olsen. Under relevant case law and according to MPEP section 2143.01, a suggestion or motivation is needed to modify a reference and there are three possible sources for a motivation: the nature of the problem to be solved; the teachings of the prior art; and the knowledge of persons of ordinary skill in the art. *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998). MPEP 2143.01 explains more specifically when it is and is not proper to find motivation to modify a reference under 35 U.S.C. Sec. 103.

UNFIT FOR ITS INTENDED PURPOSE

If Olsen was modified in a manner to render the amended pending claims obvious, the proposed modification to the Olsen reference would make it unsatisfactory for its intended purpose, which, according to MPEP 2143.01, means there is no motivation to modify the reference. The relevant part of the Olsen reference apparently describes how a picture is purposely obscured by segments and these segments are randomly turned over to allow the player to attempt to discern the picture. As a result, bits and pieces of the picture are randomly displayed, making it a challenge for the player to guess what the identity of the entire picture. In short, the cited section of the Olsen reference basically describes a guessing game based on randomly displaying parts of the picture.

The pending independent claims call for the first display items (cards in claims 1, 18 and 21, keno squares in claim 7, bingo squares in claim 13) to be overturned "in a predetermined non-random sequence at a predetermined speed" "wherein the portions of the display object create an identifiable image."

First, Olsen specifically calls for turning over segments on a random basis. Olsen does not mention any other basis except for a random basis. Any other basis besides a random basis would go against the teachings of Olsen.

Second, in order to modify Olsen to match the pending claims, Olsen would have to turn over segments in a non-random sequence at a predetermined speed to create an identifiable image. By modifying Olsen to include turning over segments to create an identifiable image in a non-random sequence, the purpose of Olsen of creating a mystery which the player can attempt to guess would be eliminated. The modified Olsen would not wait for the player to attempt to discern the image but would continue to turn over segments to display the image at a predetermined speed.

As called for in the pending independent claims, the image must become identifiable. There is no guessing as to the identity of the displayed image in the pending independent claims as the image is identifiable. The game aspect of the Olsen reference would be lost because all the segments would be turned over and the image would become identifiable. Olsen would no longer be fit for its intended purpose of being a guessing game because the modified Olsen would no longer be a guessing game but merely a short wait until all the segments are overturned at a predetermined speed and the picture is identifiable as called for in the pending independent claims. Therefore, according to MPEP 2143.01, there is no motivation to modify the Olsen reference because the Olsen reference would no longer be fit for its intended purpose of being a guessing game.

PRINCIPLE OF OPERATION

In addition, the proposed modification of the Olsen reference would change the principle of operation of the device disclosed in the Olsen reference, which according to MPEP 2143.01, means that there is no motivation to make the proposed modification to the Olsen reference. The Olsen reference attempts to create a game by allowing a player to guess

at the identification of a picture while the picture is obscured by segments which are randomly overturned. In other words, the principle of the Olsen reference is to make a player guess to determine a picture obscured by segments.

In order to modify Olsen to match the pending claims, Olsen would have to turn over segments on a non-random basis to create an identifiable picture. First, Olsen specifically calls for turning over segments on a random basis. Olsen does not mention any other basis except for a random basis. Any other basis besides a random basis would go against the teachings of Olsen.

Second, the principle of operation of Olsen of allowing a player to attempt to discern the picture mandates that the segments be turned over in a random way because the Olsen desires to make it a challenge for a player. The principle of operation in Olsen, a guessing game, would be lost because the player would no longer have to guess at the identification of the picture because it would be identifiable. According to MPEP 2143.01, as the proposed modification to the Olsen reference would change the principle of operation of the Olsen reference by changing it from a guessing game to a non-guessing game, there is no motivation to modify the Olsen reference.

CLAIMS 9 AND 15

Claims 9 and 15 are rejected under 35 U.S.C. Sec. 103(a) as being unpatentable over Olsen in view of Frohm et al. It is respectfully submitted that as explained above, it would be improper to modify Olsen to include all the elements of the pending independent claims, specifically, a non-random turnover of segments, and it likewise would be improper to further modify Olsen to include Frohm.

CONCLUSION

In conclusion, the applicant respectfully submits that the modified Olsen reference would no longer be a guessing game in contrast to its intended purpose and principle of operation. As a result there is no motivation to modify the Olsen reference. The applicant submits that all pending claims are novel and non-obvious and are in condition for allowance. In the light of the foregoing, the prompt issuance of a notice of allowance is respectfully solicited. Should the Examiner have any questions, she is respectfully invited to telephone the undersigned.

Respectfully submitted,

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